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10/527,909	03/14/2005	Tomoaki Endoh	03500.017742.	9057

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EXAMINER

JOHNS, CHRISTOPHER C

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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,909	Applicant(s) ENDOH, TOMOAKI	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20091202 for reference purposes only.
2. This Office Action is in response to the Response to Non-Final Office Action, filed by Applicant on 14 August 2009.
3. All references to the capitalized version of “Applicant” refer specifically to the Applicant of record in the instant application. Any references to lowercase versions of “applicant” or “applicants” refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. Claims 1-4, 6-10, 12, and 13 are pending.
5. Claims 1-4, 6-10, 12, and 13 have been examined.

Claim Rejections - 35 USC § 112 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-4, 6-10, 12, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed

invention. Independent claims 1, 7, and 13 all recite “acquiring, via a network ... device identification information”. The acquisition of device identification (and device identification alone, as the claim is written) is unsupported by the specification and claims as originally filed.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-4, 6-10, 12, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Independent claim 1, 7, and 13 all recite “gives a user an authority to use a program for the printing apparatus”. It would be unclear to a person having ordinary skill in the art whether the authority is given to the user in order to allow him to use a program:

11. that is installed on the printing apparatus; or

12. on behalf of the printing apparatus.

13. In light of the below definition of “for”, the claim’s metes and bounds are unclear because of the two different interpretations. A person having ordinary skill in the art would not understand the limitations of a structure that implements the claim.

14. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art

rejections even though claims may be indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-4, 6-10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Application Publication 2001/0034846 (“Beery”) in view of Adobe InDesign 1.5 (“Adobe”).

17. As per claim 1, Beery discloses:

18. management unit constructed to manage license information that gives a user an authority to use a program for the printing apparatus and that has already been installed in the printing apparatus, license information indicating an amount of allowed usage of the program executable on the printing apparatus or a function of the printing apparatus (figure 5b, reference 200);

19. management unit constructed to manage license identification information corresponding to the license information, wherein the management unit manages the license information by using a counter (figure 5b, reference 200 - note how, in figure 5, reference 80-84, the user is able to use the software in order to retrieve a missing chunk for it);

20. an acquisition unit constructed to acquire, via a network, license identification information identifying license information, device identification information, and license

information indicating an amount of a change in a right of usage of the program (figure 5b, reference 250 – the software package includes the licensing information for the software as well as the device identification sent earlier in steps 232, 233, 236);

21. a determination unit constructed to determine whether the acquired license identification information corresponding to the acquired license information is included in the license identification information managed by the management unit so as to avoid a duplicate installation of the license information (if the software already has the missing chunk, it will not be requested nor installed);

22. recognition unit constructed to recognize whether the acquired device identification information corresponds to device identification information of the printing apparatus (figure 5c, reference 308 - see step 362, where device identification information is sent to 308);

23. an installation unit constructed to, if the determination unit determines that the acquired license identification information corresponding to the acquired license information is not included in the license identification information managed by the management unit (figure 5c, reference 374), and if the recognition unit recognizes that the acquired device identification corresponds to the device identification information of the printing apparatus (figure 5c, reference 376), install the acquired license information to increase the amount of allowed usage of the program (figure 5c, reference 364);

24. wherein the installation unit does not install the acquired license information if the determination unit determines that the acquired license information corresponding to the acquired license information is included in the license identification information managed by the management unit or if the recognition unit recognizes that the acquired device identification

information does not correspond to the device identification information of the printing apparatus (figure 5c, reference 364 – “if registration ok, then allow H1 to continue”; implying that if the registration is NOT okay, then H1 would not continue).

25. Beery does not explicitly disclose:
26. printing unit constructed to execute a printing process;
27. increasing the amount of allowed usage of the program by operating the counter.
28. Adobe teaches:
29. printing unit constructed to execute a printing process (“Impose printer spreads - Extend your printing options in InDesign with plug-ins from alap inc.”);
30. increasing the amount of allowed usage of the program by operating the counter.
31. Adobe teaches this to enable a demonstration version of software, well-known to those skilled in the art at the time of the invention as a method for distributing trial versions of software without giving the entire functionality away for free. This enables a system where users are more satisfied (as they are able to try out the software and evaluate it before purchasing) and where merchants are more satisfied (as customers who know what they are getting into are more likely to buy the software).
32. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Beery the trial system as taught by Adobe, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would

have recognized that the results of the combination were predictable, as well as advantageous because it creates a system that users are more likely to use and purchase.

33. Claims 7 and 13 are similar to claim 1 and are rejected for the same reasoning.

34. As per claims 2 and 8, Beery in view of Adobe discloses as above, and further discloses:

35. management means further manages expiration-date-of-installation information indicating a period during which the license information acquired by the acquisition means is valid (¶10 – “time sensitive token”; ¶12 – “exceeded the licensed time limit”);

36. authentication means for authenticating the expiration date of installation of the license information (¶10 – “time sensitive token which is encrypted”).

37. As per claims 3 and 9, Beery in view of Adobe discloses as above, and further discloses:

38. management means manages an encryption key of an already-installed program code (claim 3 – “said data or software being encrypted by standard encryption technology”) together with program identification information identifying the program (figure 5b, reference 246, 248)

39. As per claims 6 and 12, Beery in view of Adobe discloses as above, and further discloses:

40. management means manages license information in the form of certification information, which certifies the right of a particular amount of usage of the program installed on the image forming apparatus or the function of the image forming apparatus (the license certifies that the program is able to act in a certain way).

41. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beery in view of Adobe, further in view of Official Notice.

42. As per claims 4 and 10, Beery in view of Adobe teaches as above, but does not explicitly teach:

43. acquired license information encrypted using an encryption key uniquely assigned to the image forming apparatus;

44. image forming apparatus comprises decryption means for decrypting the encrypted license information

45. It is Admitted Prior Art that the idea of "device keys" was old and well-known in the art because it allows for a device-centric method of encrypting data, which does not depend upon user keys to be entered. Device keys have been used in countless Digital Rights Management systems, and are known to be advantageous because they allow for a stronger system - if a device is known to act in a way that the content owners do not desire, the solution is to no longer issue content tied to that device. This is accomplished by encrypting data to a key in such a way that it is only decryptable by a specific unit

46. The prior art is replete with this idea (see, for example, United States Patent Application Publication 2002/0007456, paragraph 312 - "To constitute the code image 78, and in one embodiment of the present invention, there is a manufacturer-specific device key KMAN which is unique to each portable device 62 but independent of the CPU key 66. The purpose of KMAN is to allow each device manufacturer to administrate its device secrets independently").

47. Therefore, it would have been obvious to a person having ordinary skill in the art to include in a "device key" in Beery and Adobe, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable. Furthermore, a person having ordinary skill in the art would see this as advantageous because it allows for a more secure system - if a device is found to be non-compliant, a content creator merely has to cease issuing content tied to that device, and the chain of data security remains intact.

Claim Interpretation

48. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

49. ***Construct***: "to put together substances or parts, especially systematically, in order to make or build...assemble", Collins English Dictionary, HarperCollins Publishers, 2000.

50. ***For***: "representing; on behalf of someone", Chambers 21st Century Dictionary, Chambers Harrap Publishing, 2001.

51. In light of the above definition for "construct", the Examiner finds that the recitation of "constructed to" (claim 1) is an example of functional language. Additionally, the recitations in

claims 1, 7, and 13, of “so as to avoid a duplication installation of the license information” is also found to be a functional limitation. Applicants are reminded that though there is nothing inherently wrong with functional language, this language does not ordinarily assist in overcoming the prior art. See MPEP §2114. It is believed that Applicants intend “constructed to” to mean “programmed to” since “constructed to” is functional language and therefore given less patentable weight. For this same reason, it is also believed that Applicants intend “so as to avoid...” to be understood in a positive and limiting sense, rather than an intended use sense. In light of the notice function of the claims, the Examiner respectfully requests changing “constructed to” to “programmed to”, as well as reworking the recitation of “so as to avoid...” where positive recitations are desired. See MPEP §2114.

Response to Arguments

52. Concerning the above-given rejection under 35 USC §112 1st Paragraph - based on Applicant’s arguments, it appears that he interprets the “device identification information” to be part of the “license identification information”; however, as the items are listed using commas, a reasonable interpretation (the one that the Examiner took in this case) is that the “device identification information” is separate from the “license identification information” - i.e. all three portions (“license identification information”, “device identification information”, and “license information indicating an amount of a change...”) being separate pieces of data.

53. Most of Applicant’s arguments concerning the claims amount to mere allegations of patentability. The format of the arguments consists of a description of the invention (page 11, ¶4 - page 12, ¶1: “The present invention...”), an explicit admission that claims 7 and 13

“substantially correspond to claim 1” (page 12, ¶2), then a statement that “the applied art” does not disclose certain features of the invention (page 12, ¶3 - page 16, ¶1).

54. The sole place that the primary reference (“Beery”) is pointed to by the Applicants, on ¶2 of page 13, recites that “Beery is not seen to relate to the task of inhibiting the duplicate installation of license information via license identification information as claimed”. The Examiner disagrees. Firstly, the language cited by Applicant (“inhibiting the duplicate installation of license information via license identification information”) was not found in the claims.

55. Secondly, it is noted that Beery will not request the software chunk if it is already installed - figure 5 notes that the missing data chunk will be requested only when the software is “missing” the chunk (reference 82).

56. Furthermore, if a reviewing body finds that Beery does not contain “inhibiting the duplicate installation of license information via license identification information as claimed”, then the Examiner points to the previously-included document entitled “Error Message - Another version is already installed - Can’t install” (included with the Final Office Action of 26 November 2008). Clearly, it was well-known to those skilled in the art at the time of the invention to inhibit the reinstallation of software that has already been installed.

57. Finally, Applicant is directed to a posting from the alt.comp.shareware.programmer newsgroup, from 1 August 1997, discussing methods of how to “prevent reinstallation of expired shareware”.

Conclusion

58. Applicant's amendment, filed on 14 August 2009, necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

59. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

60. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

61. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

62. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621